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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,406	10/01/2003	Jhunu Chatterjee	19585-0017	8053
29052	7590	04/20/2005		
SUTHERLAND ASBILL & BRENNAN LLP 999 PEACHTREE STREET, N.E. ATLANTA, GA 30309			EXAMINER ACQUAH, SAMUEL A	
			ART UNIT 1711	PAPER NUMBER
DATE MAILED: 04/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,406

Applicant(s)

GHATTERJEE ET AL.

Examiner

SAMUEL A. ACQUAH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-36 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a emulsion". The recitation renders the claim indefinite. It is herein suggested that the recitation be changed to ---an emulsion---.

Claim 29 recites "agent made a method". The recitation should be changed to ---agent made by a method".

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 13-18, 21, 22, 29-33, 35, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Ugelstad et al 4,774,265.

The cited prior art discloses a process for preparing magnetic polymer particles comprising a microencapsulated agent, by forming an emulsion comprising the agent and a crosslinkable material in an oil phase, and heating the emulsion to form a microcapsules that are superparamagnetic, and may be used for medical, diagnostic or other purposes. The agent comprises iron or together with other metal compounds such as cobalt or nickel. See columns 2 and 6.. The process is useful for making particles of all sizes, particularly in the size range 0.5-20 microns or larger in diameter, see column

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2, 6 et seq., and Examples 1-4, and 25. Other physical characteristics not expressly discloses would appear to be inherent in view of the total process conditions and the components used.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12, 20, 23-28, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugelstad et al '265.

The disclosures of the cited prior art are as discussed above. Patentees teach in column one, line 35 et seq., that other methods for the encapsulated agent employ the admixture of albumin and other proteins with magnetite and vigorous stirring in water with emulsifier to form the microcapsule particle. The microcapsulated agent is used for binding ligands. Thus, it is the Examiner's position that the use of biodegradable matrices in the preparation of superparamagnetic agents to bind ligands would have been obvious to the ordinary practitioner based on the disclosures of the cited prior art.

4. Claims 9-12, 23-28, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugelstad et al '265 as applied to the claims above, and further in view of Ugelstad et al 5,763,203.

This prior art also teaches the immobilization and separation of cells and other particles using superparamagnetic particles wherein the protein-binding may be avidin

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or streptavidin, see column 6, line 51 et seq. The claimed method and composition would have been obvious in view of the teachings of the cited prior arts.

5. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Other references listed on PTO-1449 have been made part of the record.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL A. ACQUAH whose telephone number is 571-272-1065. The examiner can normally be reached on M-TH, FRIDAYS OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES SEIDLECK can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

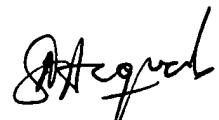
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04/15/05


SAMUEL A. ACQUAH
PRIMARY EXAMINER
GROUP ~~120~~ 1700